

RECEIVED
CENTRAL FAX CENTER

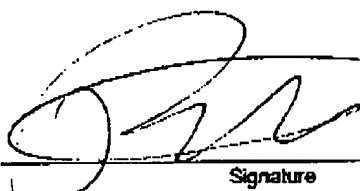
MAR 09 2006

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through x0/xx/200x OMB 0651-000x
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) CAD5048AP07	
I hereby certify that this correspondence is being transmitted by facsimile under 37 C.F.R. §1.8 to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Facsimile No: (571) 273-8300. on <u>March 9, 2006</u> Signature <u><i>Kathleen Faughnan</i></u> Typed or printed name <u>Kathleen Faughnan</u>		Application Number <u>09/918,600</u>	Filed <u>7/30/01</u>
		First Named Inventor <u>Tseng</u>	
		Art Unit <u>2128</u>	Examiner <u>Saxena, Akash</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record <u>34,682</u> Registration number <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature <u>Raymond R. Moser Jr.</u> Typed or printed name <u>(732) 935-7100</u> Telephone number <u>March 9, 2006</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

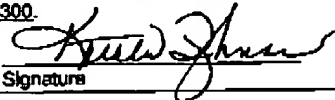
This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

26788

PAGE 4/9 * RCVD AT 3/9/2006 1:51:11 PM [Eastern Standard Time] * SVR:USPTO-EFXXF-3/22 * DNIS:2738300 * CSID:7329357122 * DURATION (mm:ss):03:14

MOSEY IP LAW GROUP, LLC → PTO OFFICE
RECEIVED
CENTRAL FAX CENTER**MAR 09 2006 PRE-APPEAL BRIEF REQUEST FOR REVIEW**
Serial No. 09/918,600
Page 1 of 5**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**Appellants: Tseng et al.
Serial No.: 09/918,600
Examiner: Saxena, Akash
Confirmation No.: 3642Case: CAD5048AP07
Filed: July 30, 2001
Group Art Unit: 2128Title: **BEHAVIOR PROCESSOR SYSTEM AND METHOD**Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. §1.8	
I hereby certify that this correspondence is being transmitted by facsimile under 37 C.F.R. §1.8 on <u>3/9</u> , 2006 and is addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Facsimile No: (571) 273-8300.	
March 9, 2006	
Date	Signature

S I R:

REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated December 9, 2005, having a shortened statutory period set to expire on March 9, 2006, please consider this Pre-Appeal Brief Request for Review (*Request*), submitted together with a Notice of Appeal, to review the clear error of the Examiner with respect to the pending claims.

The Examiner has objected to claims 28-29 and 33-34 as containing limitations expressed in unclear language such that the Examiner considers claims 28 and 29 to be synonymous. The Appellants submit that the scope of claims 28 and 29 is significantly different and, therefore, cannot be considered synonymous. For example, in one embodiment of the invention, the testbench process is one of the processes that is executed by the host workstation. As recited in Claim 27, when a service request occurs a signal is sent to the testbench process in the host workstation. Claims 28 and 29 separately claim which component, "workstation" generally or "testbench process" specifically, will service the signal. The general use of the host workstation to service the signal (claim 28) is of significantly different scope than the recitation of using the specific testbench process to service the signal (claim 29). For example, claim 28 contemplates that the host workstation may suspend the operation until the signal is serviced. Since the claim is silent regarding what specific process may service the

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Serial No. 09/918,600

Page 2 of 5

signal, a process other than the testbench process may service the signal. In contrast, claim 29 specifically recites that the testbench process operates to service the signal. Thus, claim 29 is narrower in scope than claim 28. Since the scope of these claims is substantially different, claims 28 and 29 should not be considered synonymous. As such, in view of the argument herein and the previously filed response to the Final Office Action, the Appellants respectfully request that the objection to claims 28-29 and 33-34 be withdrawn.

The Examiner has rejected claims 1-11, 13-15, 17-30, 32-34, and 36 under 35 U.S.C. 102 (b) as anticipated by United States Patent No. 5,838,948 issued Nov. 17, 1998 to *Bunza* (hereinafter referred to as "*BU'948*"). The interpretation of *BU'948* by the Examiner is clearly erroneous. Simply stated, *BU'948* does not teach using a programmable logic element for modeling a portion of a design that includes a behavioral function. In support of the rejection, the Examiner has cited a specific clause of *BU'948* and used the inherency doctrine for the basis of this rejection. The Appellants contend that this rejection is incorrect as a matter of law and fact. In addition, the Appellants submit that, even if, *arguendo*, the Examiner's basis for the rejection is correct, the reference does not contain an enabling disclosure regarding modeling a behavioral function in a programmable logic element.

BU'948 states, at column 9, lines 49-52, that the "use of unsynthesizable behavioral or high-level design representations, typical of early stages of design, are precluded by the use of hardware emulators." In the Final Office Action, at the top of page 4, the Examiner states that this quote teaches that "unsynthesizable" behavioral representations are precluded from being synthesized in a hardware emulator. The Appellants agree. The Examiner further states that this clause "does not teach that synthesizable behavioral representations of the design are precluded from being synthesized in hardware emulator." Further, the Examiner states that it is inherent from this teaching in *BU'948* that "behavioral or high level representations can be synthesized into hardware emulator". The Examiner is contending that the statement that "unsynthesizable" behavioral representations are not emulated in hardware, somehow implies that synthesizable behavioral representations are able to be

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Serial No. 09/918,600

Page 3 of 5

emulated in hardware. The Appellants believe that as a matter of law and fact, the Examiner can not conclude that hardware modeling of synthesizable behavioral representations are inherently disclosed from the BU'948 reference.

The mere fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Thus, "[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted); see also, MPEP §2112 IV. Because BU'948 made a statement about "unsynthesizable" functions does not "necessarily and inevitably" teach that synthesizable behavioral functions can be modeled in hardware. As is well-known in the art (see BU'948 at col. 5, lines 65-66), synthesizable behavioral functions may be modeled in software, i.e., a simulation. Consequently, the silence regarding synthesizable functions in BU'948 does not necessarily and inevitably lead one skilled in the art to model such behavioral functions using a programmable logic element. Clearly, such functions could be modeled in software. Therefore, since the Examiner has agreed that BU'948 states that unsynthesizable behavioral functions are not modeled in hardware and the above argument shows that synthesizable behavioral function modeling is not inherent from the statement in BU'948, the Appellants submit that BU'948 does not teach modeling of behavioral functions in a programmable logic element. Thus, the rejection based upon BU'948 is improper and should be withdrawn.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Serial No. 09/918,600

Page 4 of 5

The Examiner states in the Examiner's Advisory Action on page 2, "There is no support in the specification that teaches unsynthesizable behavioral level function can be synthezied [sic] in the hardware emulator." The Appellants respectfully disagree with this contention and point out that the specification fully supports modeling of behavioral level functions by the emulator. Specifically, page 192 of Appellants' specification states:

"One embodiment of the present invention provides a system that generates hardware elements from normally non-synthesizable code elements for placement on an FPGA device. This particular FPGA device is called a Behavior Processor. This Behavior Processor executes in hardware those code constructs that were previously executed in software."

Clearly, the Appellants specification teaches that the present invention models in hardware elements that were previously non-synthesizable. *BU'948*, in contrast, teaches away from this particular embodiment of the invention stating "[u]se of unsynthesizable behavioral or high-level design representations, typical of early stages of design, are precluded by the use of hardware emulators." As such, the present invention comprises a particular embodiment that *BU'948* states is not possible.

Furthermore, *BU'948*, even if, *arguendo*, the modeling of synthesizable behavioral functions were inherent from the statement that unsynthesizable behavioral functions were precluded from hardware modeling, the teachings of *BU'948* do not show how one skilled in the art would model a behavioral function in a programmable logic element. Since *BU'948* is silent regarding the specific nature and use of such functions in hardware, the Appellants submit that a teaching of an implementation can not be inherent from the statement above, i.e., *BU'948* is not enabling with regard to the Appellants invention.

"The mere fact that a disclosure is contained in a patent or application and thus constructively reduced to practice, or that it is found in a printed publication, does not make the disclosure itself any more meaningful to those skilled in the art (and thus, ultimately, to the public). Rather, the criterion is whether the disclosure is sufficient to enable one skilled in the art to reduce the disclosed invention to practice. In other words, the disclosure must be such as will give possession of the invention to the person of ordinary skill. Even the act of publication or the fiction of constructive reduction to practice will not suffice if

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Serial No. 09/918,600

Page 5 of 5

the disclosure does not meet this standard." In re Borst, 52 C.C.P.A. 1398, 345 F.2d 851, 854, 145 U.S.P.Q. (BNA) 554, 556 (CCPA 1965).

One skilled in the art could not be taught to create a hardware model of a behavioral function from silence. As such, the Appellants submit that the rejection based upon BU'948 is improper for this additional reason and the rejection should be withdrawn.

Appellants' claim 1 specifically recites a reprogrammable logic element for modeling a hardware model of the portion of the user design that includes a behavioral level function. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). Since, as argued above, BU'948 lacks any disclosure of a behavior level function being modeled in a reprogrammable logic element nor a testbench call back process, the Appellants contend that claims 1-11, 13-15, 17-30, 32-34, and 36 are patentable over BU'948 and, as such, fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder.

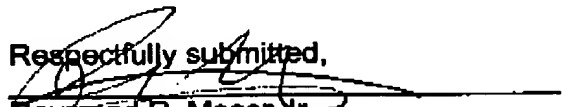
The remaining claims in the present application stand rejected under 35 U.S.C. 103(a). See, Examiner's Final Office Action p.5-8. The rejections are based upon various combinations of prior art with BU'948. As discussed above, BU'948 does not anticipate the Appellants' present invention. As previously filed responses have argued, the additional cited prior art, singly or in combination, with BU'948 does not render Appellants' invention obvious under 35 U.S.C. 103(a).

Thus, the Appellants submit that the rejection based on BU'948 should be withdrawn and all claims now pending should be allowed.

If, however, the Examiner believes that there are any unresolved issues in the application, it is requested that the Examiner telephone Mr. Raymond R. Moser Jr. at (732) 935-7100 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

3-9-06

Respectfully submitted,


Raymond R. Moser Jr.
Attorney Reg. No. 34,682
(732) 935-7100